

REMARKS/ARGUMENTS

In light of the above amendments and following remarks, reconsideration and allowance of this application are respectfully requested.

I. STATUS OF THE CLAIMS AND FORMAL MATTERS

Claims 1-4, 6, 13-18, 20, 27 and 28 are pending in this application and have been rejected in the Office Action. In this response, claims 1, 15-18, 20 and 28 have been amended and claims 13 and 27 have been canceled without prejudice to their subsequent prosecution in any continuing application or disclaimer of the proprietary rights set forth therein. No new subject matter is added as a result of the amended claims.

It is submitted that these claims are patentably distinct from the prior art cited by the Examiner, and that these claims are in full compliance with the requirements of 35 U.S.C. §112. The remarks made herein are not made for the purpose of patentability within the meaning of 35 U.S.C. §§ 101, 102, 103 or 112, but rather the amendments and remarks made herein are simply for clarification and to round out the scope of protection to which Applicants are entitled.

In paragraph 1 of the Office Action, the Examiner states that because the Applicants did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse. Applicants respectfully disagree with the assertion that the election was made without traverse. On page 1 of the "Response to Restriction Requirement and Amendment" filed on April 4, 2005, Applicants specifically stated that they elected, with traverse, Species 1. On page 8 of the Response, Applicants further indicated that claims 1 and 15 have been amended and that as amended, Applicants believed that claims 1 and 15 were generic to Species I, II, III and IV. Therefore, it is respectfully requested that the Examiner indicate that the election was made "with traverse."

In paragraphs 3 and 4 of the Office Action, claims 13, 27 and 28 were objected to as either being of improper dependent form or as being drawn to "the filament of claim 15" instead of "the fabric of claim 15." In response, claims 13 and 27 have been canceled and claim 28 has been amended to recite "the industrial fabric of claim 15." Therefore, it is respectfully requested that the claim objections be withdrawn.

II. THE REJECTIONS UNDER 35 U.S.C. § 102(b), 35 U.S.C. § 102(e) and 35 U.S.C. § 103(a)

In paragraph 7 of the Office Action, claims 1-4, 6 and 13 have been rejected under 35 U.S.C. § 102(b) as being anticipated, or in the alternative, under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 3,800,019 to Parsey et al. ("Parsey").

In paragraph 8 of the Office Action, claims 1-4, 6 and 13 have been rejected under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under §103(a) as obvious over U.S. Patent No. 6,653,943 to Lamb et al. ("Lamb").

In paragraph 10 of the Office Action, claims 1-4, 6, 13-18, 20, 27 and 28 have been rejected under § 103(a) as being unpatentable over U.S. Patent No. 5,685,014 to Dapsalmon ("Dapsalmon") in view of any one of Parsey or Lamb.

Lastly, in paragraph 12 of the Office Action, claims 1-4, 6, 13-18, 20, 27 and 28 have been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over U.S. Patent No. 6,786,243 to Moriarity et al. ("Moriarity") in view of any one of Parsey or Lamb.

The rejections are traversed for at least the following reasons.

As recited in revised claim 1, the instant invention is directed to a filament for use in an industrial fabric used in papermaking and related industries where the filament has a core surrounded by a plurality of respective layers and a means for indicating the level of wear of an

industrial fabric comprised thereof. Therefore, in the instant invention, the individual filaments are each surrounded by a plurality of wear indicating layers. *See* page 6, lines 3-17. The plurality of layers not only indicate the level of wear of filaments in the industrial fabric, but the plurality of layers also add to the structural integrity of the filament. Therefore, the filaments of the instant invention have structural properties that degrade as wear occurs to the industrial fabric that is formed from the filaments.

In addition, since these filaments are incorporated into an industrial fabric, upon wearing, the filaments are not "resheathable" in order to restore structural integrity to the filament and hence the industrial fabric formed thereof. That is, once the industrial fabric shows indications of wear and hence a decrease in the filament's original properties or characteristics, the filaments cannot be restored to their original state in order to be reused. Therefore, as the filaments wear, the structural integrity and the useful life of the industrial fabric decrease as well.

In contrast, Parsey is directed to a rope structure constructed from a core of at least one bundle of filaments, wherein the core may be bound by a steel tape or wire or sheathed with two organic coatings of different colors. In these configurations, damage or wear to the rope can be detected by measuring the resistance between the steel binding means or by a change in the color on the outside of the rope. Parsey further states that a feature of the sheathed ropes that become worn is that their useful life may be considerably increased by resheathing of the bundle of filaments. *See* col. 1, line 39 - col. 2, line 29. Therefore, Parsey teaches a bundle of filaments that are sheathed, whereas the instant invention teaches a single filament that is surrounded by a plurality of respective layers. Parsey also teaches that the bundle of filaments is used to produce rope structures, whereas the instant invention is directed to filaments used to form industrial fabrics. Lastly, Parsey teaches that the organic coating sheathing is not functioning as an integral part of the primary purpose of the rope structure which is stretch resistance since the ropes can

be re-sheathed when worn, whereas in the instant invention, the plurality of respective layers are integral to the structural integrity of the filament and the industrial fabric and as they wear, the structural properties of both the filaments and the industrial fabric degrade as well. Since the filaments of the instant invention are incorporated into industrial fabrics, they cannot be re-sheathed and restored to their original condition.

Lamb, in contrast, is directed to suspension ropes having polyurethane sheaths as used, for example, in an elevator assembly. Col. 2, lines 26-28. As depicted in Figure 1a, the suspension or wire rope 4 is constructed from a wire rope that includes a plurality of load supporting wire members or strands. Col. 3, lines 16-20. In various embodiments, the wire rope in its entirety (which includes the plurality of wires or strands) is encased in sheaths of materials having differing properties where the properties of the sheath material are used to detect an amount or wear on the suspension rope. Therefore, Lamb teaches a plurality of wire members or strands that are sheathed, whereas the instant invention teaches a single filament that is surrounded by a plurality of respective layers. Lamb also teaches that the plurality of wire members or strands are used to produce a suspension rope used, for example, in an elevator assembly, whereas the instant invention is directed to filaments used to form industrial fabrics. Similarly to Parsey, once wear on the suspension rope is detected, the rope can be taken out of service and re-sheathed to return the suspension rope to its original condition, thereby extending the life of the suspension ropes. As previously stated, the filaments of the instant invention cannot be re-sheathed and restored to their original condition.

Dapsalmon, in contrast to the instant invention, is directed to a knitted piece of protective gear, such as a glove, to protect a person's limbs against injury. See col. 1, line 66 - col. 2, line 3. The piece of protective gear is knitted from yarns containing a core of a first color and an outer fiber covering of a second color. Damage to the knitted protective gear is detected by a change

in color on the outer surface of the protective gear. Hence, Dapsalmon is not directed to detecting wear in an industrial fabric by detecting wear of the individual filaments that form the industrial fabric.

Regarding Moriarity, as depicted in Figure 3, Moriarity is directed to a sheath/core yarn 20 that includes a core yarn 22 and a single sheath 24. Col. 3, lines 6-33. The sheath/core yarn of Moriarity is for use in an industrial fabric. In contrast, the instant invention is directed to a filament having a core surrounded by a plurality of respective layers. The Office Action states that although Moriarity does not specifically mention the use of a plurality of respective outer layers, Parsey and Lamb each disclose that it is known in the wear detecting filament art that a core may be surrounded by a plurality of outer layers to indicate the degree of wear. Therefore, the Office Action asserts that it would have been obvious to a person skilled in the art to make the filament of Moriarity with a plurality of outer layers. Applicants respectfully disagree.

Applicants contend that Parsey, Lamb and Dapsalmon are nonanalogous art to both the instant application and Moriarity, and therefore cannot be properly applied to reject Applicants' claims. As previously discussed, Applicants' invention is directed to a filament having a core surrounded by a plurality of respective layers that are used to indicate the level of wear of an industrial fabric constructed therefrom. Parsey, in contrast, is directed to a rope structure constructed from a core of at least one bundle of filaments, wherein the core may be bound by a steel tape or wire or sheathed with two organic coatings of different colors. Lamb, in contrast, is directed to suspension ropes having polyurethane sheaths as used, for example, in an elevator assembly. Dapsalmon, in contrast, is directed to a knitted piece of protective gear, such as a glove, to protect a person's limbs against injury. Lastly, Moriarity is directed to a sheath/core yarn that includes a core yarn and a single sheath where the sheath core yarn is used to construct an industrial fabric.

It is well established that nonanalogous art cannot be considered pertinent prior art under § 103 and therefore cannot be relied upon as a "'basis for rejection of an applicant's invention'." See M.P.E.P. § 2141.01(a) (quoting *In re Oetiker*, 977 F.2d 1443, 1446 (Fed. Cir. 1992)). The determination as to whether a reference is analogous art is two fold. First, it must be decided if the reference is within the field of the inventor's endeavor. If it is not, it must then be determined whether the reference is "reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d at 1446. The Federal Circuit has held:

A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem.

In re Clay, 966 F.2d 656, 659 (Fed. Cir. 1992).

In the present case, the Parsey, Lamb and Dapsalmon references do not satisfy the above well established test of a reference falling into the category of analogous art. First, the references are not within the field of the instant inventors' endeavor. As previously discussed, the instant invention relates to filaments for use in industrial fabrics. By contrast, Parsey relates to rope structures; Lamb relates to suspension ropes; and Dapsalmon related to knitted protective gear such as a glove. Further evidencing the different fields of invention between the instant invention and Parsey, Lamb and Dapsalmon, are the USPTO classifications of the references. See M.P.E.P. § 2141.01(a). As detailed in the Application Data tab on the PAIR system for the instant application, the instant invention is classified in class 442. Similarly, Moriarity is classified in classes 442 and 139. In contrast, Parsey is classified in classes 264 and 156; Lamb is classified in classes 340, 73 and 324; and Dapsalmon is classified in class 2. The classes are defined as follows:

Class 442 (Applicant's invention and Moriarity): Fabric (Woven, Knitted or Nonwoven Textile or Cloth, etc.)

Class 139 (Moriarity): Textiles: Weaving

Class 264 (Parsey): Plastic and Nonmetallic Article Shaping or Treating: Processes

Class 156 (Parsey): Adhesive Bonding and Miscellaneous Chemical Manufacture

Class 340 (Lamb): Communications: Electrical

Class 73 (Lamb): Measuring and Testing

Class 324 (Lamb): Electricity: Measuring and Testing

Class 2 (Dapsalmon): Apparel

Accordingly, Parsey, Lamb and Dapsalmon are neither within the field of the instant inventors' endeavors, nor are they within the field of the Moriarity reference applied in combination.

Secondly, Parsey, Lamb and Dapsalmon are not reasonably pertinent to the particular problem with which the instant inventors were involved, thus failing the second prong of the test. As previously stated, Parsey relates to rope structures; Lamb relates suspension ropes; and Dapsalmon relates to knitted protective gear such as a glove. In contrast, the instant invention is directed to problems associated with wear of an industrial fabric. It is clear that the matters with which Parsey, Lamb and Dapsalmon deal would not logically have commended themselves to the instant inventors' attention in considering the problem to be solved by the instant invention.

Therefore, as Parsey, Lamb and Dapsalmon fail both prongs of the analogous art test, they are nonanalogous art to the instant invention and cannot be properly applied in an obviousness analysis.

Moreover, while the USPTO classification is some evidence of analogy, similarities and differences in structure and function carry more weight. *In re Ellis*, 476 F.2d 1370, 1372

(C.C.P.A. 1973). As previously discussed, the Applicants' invention is directed to filaments that are used to detect wear in an industrial fabric. In contrast, neither Parsey, Lamb nor Dapsalmon perform a function similar to detecting wear of an industrial fabric. Instead Parsey relates to detecting wear of rope structures comprised of bundles of filaments; Lamb relates to detecting wear of suspension ropes for use in, for example, elevator assemblies, and Dapsalmon is directed to detecting wear in knitted protective gear, such as a glove. Hence, the differences in structure and function of the cited references are further evidence of nonanalogous between Applicants' invention and the cited references.

Since, as outline above, Parsey and Lamb are nonanalogous to both the instant invention and Moriarity, it is requested that obviousness-type double patenting rejections be withdrawn. In the alternative, it is respectfully requested that the Examiner hold the Moriarity rejections in abeyance until one or more of claims 1-4, 6, 13-18, 20, 27 and 28 are found allowable.

For at least the foregoing reasons, it is respectfully submitted that amended independent claims 1 and 15 patentably distinguish over Parsey, Lamb, Dapsalmon and Moriarity either alone or in combination, and are therefore allowable. Further, claims 2-4, 6, 13 and 14 that depend from claim 1 and claims 16-18, 20, 27 and 28 that depend from claim 15, are allowable therewith.

Statements appearing above with respect to the disclosures in the cited references represent the present opinions of the Applicant's undersigned attorney and, in the event that the Examiner disagrees with any such opinions, it is respectfully requested that the Examiner specifically indicate those portions of the respective reference providing the basis for a contrary view.

CONCLUSION

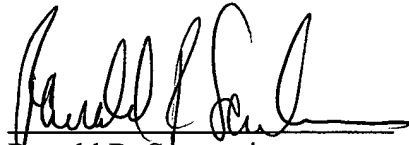
In view of the foregoing, it is believed that all of the claims in this application are

patentable over the prior art, and an early and favorable consideration thereof is solicited.

Please charge any fees incurred by reason of this response and not paid herewith to
Deposit Account No. 50-0320.

Respectfully submitted,
FROMMER LAWRENCE & HAUG LLP

By:

A handwritten signature in black ink, appearing to read 'Ronald R. Santucci', written over a horizontal line.

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